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PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of Robert J. DiStasio, et al.

Serial No. 10/015,408

Examiner James Smith

Filed: December 12, 2001

Group 3723

For: Removal Tool for Locking Nut, Bolt and Clip Systems and Assemblies

RENEWED PETITION UNDER 37 C.F.R. § 1.137(b)

Mail Stop PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

JUN 24 2004

OFFICE OF PETITIONS

Sir:

This is a Renewed Petition under 37 C.F.R. § 1.137(b) and a request to reconsider the petition to revive the abandoned captioned patent application. Accompanying this Renewed Petition are the following documents:

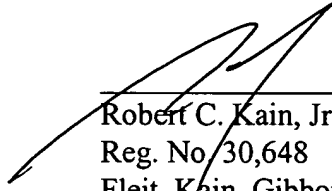
1. Request for Reconsideration
2. copy of the decision dated June 16, 2004 denying the petition
3. copy of the original Petition to Revive
4. copy of the Statement in Support of Petition to Revive
5. copy of the Reply omitted from the original Petition to Revive

The Reply was inadvertently not enclosed with the original petition. Upon receipt of the enclosed denial (item 2), petitioner filed this request for reconsideration and renewed petition without delay. Petitioner was diligent in filing the present paper.

Please reconsider and grant this renewed petition.

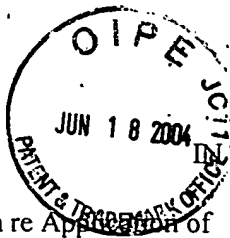
If the fees are inadequate, please debit or credit Deposit Account No.03-1231 for any overpayments/underpayments.

Respectfully submitted,



Robert C. Kain, Jr.
Reg. No. 30,648
Fleit, Kain, Gibbons, Gutman, Bongini & Bianco, P.L.
750 Southeast Third Avenue, Suite 100
Ft. Lauderdale, Florida 33316-1153
Telephone: 954-768-9002
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PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Robert J. DiStasio, et al.

Serial No. 10/015,408

Examiner James Smith

Filed: December 12, 2001

Group 3723

For: Removal Tool for Locking Nut, Bolt and Clip Systems and Assemblies

PETITION TO REVIVE ABANDONED PATENT APPLICATION

RECEIVED

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

JUN 24 2004

OFFICE OF PETITIONS

Sir:

Applicant/Petitioner, hereby files a petition to revive the abandoned captioned patent application pursuant to 37 C.F.R. § 1.137(b). Petitioner unintentionally failed to properly respond to various Office Actions relative to an election of species due February 28, 2003. Applicant filed a petition to withdraw a holding of abandonment on February 12, 2004 and on March 9, 2004, the Patent and Trademark Office denied this petition (see attached). Applicant files herewith a Response which applicant believes fully and correctly responds to the patent examiner's concerns. Applicant is now seeking to revive the abandoned captioned patent application.

The required reply, and the petition fee pursuant to 37 C.F.R. § 1.17(m)(\$665.00) and a Statement by Petitioner's representative that the entire delay in filing the required reply from the due date for the reply until the filing of this petition was unintentional. Petitioner also files a Terminal Disclaimer pursuant to 37 C.F.R. § 1.137(c) and the associated fee pursuant to 37 C.F.R. § 1.20(d)(\$55.00).

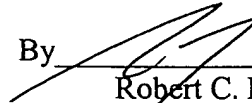
If the fees are inadequate, please debit or credit Deposit Account No.03-1231 for any overpayments/underpayments.

WHEREFORE, Applicant/Petitioner requests that the Assistant Commissioner of Patents grant this request to revive the abandoned patent application, accept the issue fee and issue the design patent accordingly.

Respectfully submitted,

Fleit, Kain, Gibbons, Gutman, Bongini & Bianco, P.L.

By



3-18-04

Robert C. Kain, Jr.

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PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Robert J. DiStasio, et al.

Serial No. 10/015,408

Examiner James Smith

Filed: December 12, 2001

Group 3723

For: Removal Tool for Locking Nut, Bolt and Clip Systems and Assemblies

STATEMENT IN SUPPORT OF PETITION TO REVIVE ABANDONED PATENT APPLICATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

JUN 24 2004

OFFICE OF PETITIONS

Sir:

Applicant/Petitioner, has filed a petition to revive the abandoned captioned patent application pursuant to 37 C.F.R. § 1.137(b). This is the Petitioner's statement:

1. Applicant's attorney of record unintentionally failed to properly respond to various Office Actions relative to an election of species due February 28, 2003.
2. Applicant's attorneys filed a petition to withdraw a holding of abandonment on February 12, 2004.
3. On March 9, 2004, the Patent and Trademark Office denied this petition stating that the earlier response of February 7, 2003 was not appropriate.
4. Applicant's attorney believed that the responses were adequate and timely but will accept the Patent and Trademark Office's determination to the contrary. Applicant's attorney hereby states that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to Rule 137(b) was unintentional.
5. Applicant files herewith a Response which applicant believes fully and correctly responds to the patent examiner's concerns.

6. Applicant is now seeking to revive the abandoned captioned patent application.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Fleit, Kain, Gibbons, Gutman, Bongini & Bianco, P.L.

By



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3-19-04



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENTS

In re Application of: Robert J. DiStasio, et al.

Serial No.: 10/015,408

Filed: December 12, 2001

For: Removal Tool for Locking Nut, Bolt and Clip Systems and Assemblies

RECEIVED

JUN 24 2004

OFFICE OF PETITIONS

TRANSMITTAL AND CERTIFICATE OF EXPRESS MAILING

Mail Stop PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I HEREBY CERTIFY that the below listed documents are being deposited with the United States Postal Service "Express Mail Post Office to Address," Mailing Label No. EO 904 075 088 US under 37 C.F.R. 1.10 on June 18, 2004 and are addressed to Mail Stop Patent Application, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

- ☒ Request for Reconsideration (1 pg.)
- ☒ Renewed Petition under 37 C.F.R. § 1.137(b) (2 pgs.)
- ☒ Copy of the Reply (2 pgs.)
- ☒ Copy of Petition to Revive Abandoned Patent Application (3 pgs.)
- ☒ Copy of Statement in Support of Petition to Revive Abandoned Patent Application (2 pgs.)
- ☒ Copy of Decision by U.S. Patent and Trademark Office (2 pgs.)
- ☒ Return receipt postcard.
- ☒ Please charge any underpayments or credit any overpayments to Deposit Account No. 03-1231. A duplicate copy of this transmittal is enclosed.

Respectfully submitted,

By

Ellen Kotler

By

Robert C. Kain, Jr.
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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MAR -9 2004



Paper No. 16

In re Application of
Robert J. DiStasio *et al*
Application No. 10/015,408
Filed: December 12, 2001
Attorney Docket No. 6177-16

DECISION ON PETITION

RECEIVED

JUN 24 2004

OFFICE OF PETITIONS

This is a decision on the petition filed by facsimile transmission on February 12, 2004 by which petitioners request withdrawal of the holding that this application stands abandoned for failure to file a timely and proper reply to the Office letter dated January 31, 2003. The petition is being considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is dismissed.

A review of the record shows that following a requirement promulgated on October 23, 2002 by which petitioners were required to elect a single claimed species of the disclosed invention for prosecution, petitioners filed numerous replies which were held to be informal and/or nonresponsive. Ultimately, this application was held to have become abandoned for failure to reply to the letter of January 31, 2003 holding that the election filed by petitioners on December 20, 2002 was informal and/or nonresponsive.

Petitioners allege that this application is not abandoned because a reply to the letter dated January 31, 2003 was in fact filed on February 7, 2003. Petitioners have established that a reply was timely filed by furnishing a copy of the reply having a 37 CFR 1.8(a) certificate of transmission affixed thereto. See 37 CFR 1.8(b).

However, the Primary Examiner reports that the February 7, 2003 reply was not a *bona fide* attempt to reply to the outstanding Office letter pursuant to 37 CFR 1.111 1.143 and 1.146, because it simply did not make an election consonant with the election requirement dated October 23, 2002. As the response was not considered to be a *bona fide* response, petitioners would have had to file a proper response and secure an extension of time pursuant to 37 CFR 1.136(a) running from the January 31, 2003 date. Obviously, that is no longer possible. See 35 USC § 133.

The application is being returned to storage as an abandoned filed pending further action by petitioners.

PETITION DISMISSED.

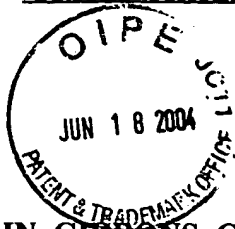
E. Rollins-Cross, Director
Technology Center 3700

Fleit, Kain, Gibbons, Gutman & Bongini, P.L.
750 S.E. Third Avenue
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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov



Paper No. **RECEIVED**

JUN 24 2004

FLEIT, KAIN, GIBBONS, GUTMAN & BONGINI, P.L.
750 S.E. THIRD AVENUE, SUITE 100
FT. LAUDERDALE, FL 33316-1153

OFFICE OF PETITIONS
COPY MAILED

JUN 14 2004

OFFICE OF PETITIONS

In re Application of
Distasio et al.
Application No. 10/015,408
Filed: December 12, 2001
Attorney Docket No. 6177-16

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed March 19, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned for failure to timely reply to the Office letter mailed January 31, 2003, which set a shortened statutory period for reply of one (1) month. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on March 1, 2003. A Notice of Abandonment was mailed December 23, 2003.

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply,
- (2) the petition fee,
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and
- (4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information.²

¹ In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

² See MPEP 711.03(c)(III)(C) and (D).

The instant petition lacks item (1). Petitioner stated that a Response was included with the instant petition submitted on March 19, 2004. However, after a review of the application file and the instant petition, the Response could not be located. Petitioner must submit a proper response to revive the above-identified application.

The Terminal Disclaimer filed on March 19, 2004 is not required since the application was not filed prior to June 8, 1995. Therefore, the Terminal Disclaimer has not been accepted and will not be entered, but will be placed in the application file. The fee for filing the Terminal Disclaimer will be credited to petitioner's deposit account as authorized.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

Effective December 1, 2003, the Office of Petitions can no longer receive hand-carried correspondence, or facsimile transmissions of correspondence. The centralized location for hand-carried correspondence is the existing Customer Window located at:

2011 South Clark Place
Crystal Plaza 1 Lobby
Room 1B03
Arlington, VA 22202

The centralized facsimile number is (703) 872-9306.

Telephone inquiries should be directed to the undersigned at (703) 306-0482.



Liana Chase
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy